



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,012	03/30/2001	Kazuyuki Yamaguchi	P/3236-27	6753

7590 05/19/2004

Steven I Weisburd Esq  
Dickstein Shapiro Morin & Oshinsky LLP  
1177 Avenue of the Americas - 4st Floor  
New York, NY 10036-2714

EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
2645	9

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/823,012	YAMAGUCHI, KAZUYUKI
	Examiner	Art Unit
	Ovidio Escalante	2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 20 February 2004.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-10 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 2,5,9 and 10 is/are allowed.  
 6) Claim(s) 1,3,4,6-8 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

1. This action is in response to applicant's amendment filed on February 20, 2004. **Claims 1-10** are now pending in the present application.

### *Allowable Subject Matter*

2. Claims 2,5,9 and 10 are allowed.

### *Claim Objections*

3. Claim 1 is objected to because of the following informalities: in line 10, a punctuation mark is apparently needed between "content data" and "each gateway unit". Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1,3,4,6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden et al. US Patent 6,549,773 in view of Uchiyama et al. US Patent 5,884,169.

*Regarding claim 1*, Linden teaches a mobile communication system (fig. 1; col. 5, line 66-col. 6, line 32) comprising:

a content server (3; col. 6, lines 21-24) for providing content data requested via a network, (col. 9, lines 1-15);  
a mobile communication terminal (MS1, MS2) for issuing a request to provide said content data via a mobile communication network, (fig. 1; col. 12, lines 46-47; abstract); and  
a plurality of gateway units (2) located respectively in predetermined areas, (col. 6, lines 21-42; several servers can be the gateway unit), for executing protocol conversion of said request and said content data transmitted between said network and said mobile communication network (fig. 1; col. 2, lines 39-42) and for continuously providing said content data from said content server to said mobile communication terminal by transmitting and receiving communication information to provide said content data, (fig. 1; abstract; col. 12, lines 29-55); each gateway unit

including an inquiry section, (fig. 1, the gateway has a request section to request information from the server 3).

Linden does not specifically teach that each gateway inquires each of the other gateway unit whether identification information of said mobile communication terminal is register in a service management information storing section.

In the same field of endeavor, Uchiyama teaches of a plurality of gateways (e.g. GMSC 261,262) and wherein each gateway unit includes an inquiry section, for inquiring of each of the other gateway units whether identification information of said mobile communication terminal is registered in a service management information storing section, (col. 4, lines 21-28,45-57).

Uchiyama also teaches that it was well known in the art to request information, in general, from the other gateway units.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Linden by allowing the plurality of gateways to send inquiries to each other as taught by Uchiyama so that roaming subscribers can receive content information while they are roaming from one area to another since each gateway will authenticate the user for sending the content by sending inquires to the other gateways.

*Regarding claims 3 and 7,* Linden teaches wherein said mobile communication network includes a plurality of radio communication base stations, each of said radio communication base stations which cover an area smaller than each of said predetermined areas and communicate one another, and at least one of said plurality of radio communication base stations transmits said request to a predetermined gateway unit among said plurality of gateway units, (fig. 1; col. 1, lines 11-33).

*Regarding claims 4 and 8*, Linden teaches wherein said request is transmitted to a gateway unit geographically nearest to said mobile communication terminal, (col. 6, lines 1-24).

*Regarding claim 6*, Linden teaches a mobile communication system (fig. 1; col. 5, line 66-col. 6, line 32) comprising:

a mobile communication terminal (MS1) for issuing a request to provide content data via a mobile communication network, (fig. 1; col. 12, lines 46-47; abstract);

a plurality of gateway units (2), each of said gateway units located respectively in predetermined areas and including a protocol conversion section for executing protocol conversion of said request and said content data transmitted between a predetermined network and said mobile communication network, (fig. 1; col. 2, lines 39-42; col. 6, lines 21-42), a request relay section for relaying said request and a terminal providing section for providing said content data to said mobile communication terminal in accordance with said request relayed by said request relay section, (col. 7, lines 9-36) and an inquiry section, (fig. 1, the gateway has a request section to request information from the server 3); and

a content server for providing said content data to a gateway unit which has issued said request relayed by said request relay section via said predetermined network, (col. 7, lines 9-36).

Linden does not specifically teach that each gateway inquires each of the other gateway unit whether identification information of said mobile communication terminal is register in a service management information storing section.

In the same field of endeavor, Uchiyama teaches of a plurality of gateways (e.g. GMSC 261,262) and wherein each gateway unit includes an inquiry section, for inquiring of each of the other gateway units whether identification information of said mobile communication terminal is

registered in a service management information storing section, (col. 4, lines 21-28,45-57).

Uchiyama also teaches that it was well known in the art to request information, in general, from the other gateway units.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Linden by allowing the plurality of gateways to send inquiries to each other as taught by Uchiyama so that roaming subscribers can receive content information while they are roaming from one area to another since each gateway will authenticate the user for sending the content by sending inquires to the other gateways.

*Response to Arguments*

8. Applicant's arguments with respect to claims 1,3,4 and 6-8 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 872-9306, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 703-308-6262. The examiner can normally be reached on M-F (6:30AM - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ovidio Escalante  
Examiner  
Group 2645  
May 14, 2004

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

